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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,710	03/04/2002	Marioara Mendelovici	1662/56402	4791

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/090,710

Applicant(s)

MENDELOVICI ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-10,20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19,21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of Claims*

Claims 1-23 are pending in the application. Claims 1-10, 20 and 22 are withdrawn from consideration by the Examiner under 37 C.F.R. 1.142 (b) as directed to non-elected subject matter.

### *Response to Election/Restriction*

Applicant's election without traverse of Group II, which includes claims 11-19, 21 and 23 in paper No.7 filed on January 2<sup>nd</sup>, 2003, is acknowledged. The requirement for restriction in Paper No. 4 is deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini et al (US Pat No. 3,112,199) and further in view of Uno et al (4,172,896).

Applicant claims a process for the preparation of 1,2-benzisoxazole-3-acetic acid.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Uno et al teach a generic process for the preparation of methane-sulfonamide derivatives such as 3-Sulfamoylmethyl-1,2-benzisoxazole (column 2, lines 17-50). Camerini et al disclose the methods and reagents for making Laminates (column 2-4 lines).

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The process taught by references is similar to applicants' invention. Uno et al disclose the reaction of the compound of the formula (II) with the amine of the formula (III) in the presence (preferably) of inert solvent, such as dioxane (column 2, line 47) to obtain methane-sulfonamide derivatives. Camerini et al teach a film of a crystalline polypropylene consisting of a reaction of 2 parts of chlorosulfonic acid in 98 parts trichloroethylene (column 3, Example 2). The difference between the process taught in the references and the claimed process herein lies merely in the variation of reagents and other reaction conditions such as incubation time, overlapping temperature ranges etc. The differences between the instant claims and the prior art references are so negligible, that one of ordinary skill in the chemical arts would expect slight variations to be within the expected purview of 35 U.S.C. 103(a). The disclosure of Uno et al and Camerini et al teach several combinations that would easily place Applicants invention in possession of the public at the time of Applicants invention was filed.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It would have been prima facie obvious since Uno et al and Camerini et al teach process which are analogous to claimed process that shows insubstantial alterations of the reagents and reaction conditions in the absence of any unobvious or unexpected results. The motivation to make the claimed process derives from the expectation that the use of analogous reagents such as chlorosulfonic acid, dioxane, methylene chloride under specific set of reaction conditions would

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have made similar products. The determination of optimum reaction conditions is routine experimentation and to one skilled in the art. Since there is an exemplary teaching of a process to obtain the claimed compounds in the prior art, one would have reasonable expectation that such modification and optimization of reaction conditions would give compounds with similar rate of recovery. In the absence of objective evidence showing an unexpected result, the obviousness rejection is deemed to be proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4532. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality

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requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

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Celia C Chang, Ph.D.  
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March 3, 2003 -